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EXAMINER

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HARRIS, S	
ART UNIT	PAPER NUMBER

3309
DATE MAILED:

03/25/93

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 1-21-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims ~~1-36~~ 1-36 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☒ Claims 3-12 and 16-29 are allowed.
4. ☒ Claims 1, 14 and 30-33 are rejected.
5. ☒ Claims 2, 13, 15 and 34-36 are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

5 The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

10 (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

15 Claim 30 is rejected under 35 U.S.C. § 102(b) as being anticipated by Taboada et al. Taboada et al disclose a method as claimed for performing ophthalmic surgery via a probe comprising inserting the distal end of a probe into the interior of an eye, aspirating material and applying laser energy into the interior of an eye (See col. 10 lines 27-50).

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

20 A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25 Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

30 Claims 1 and 14 are rejected under 35 U.S.C. § 103 as being unpatentable over Taboada et al in view of Hasson. Taboada et al discloses a laser delivery system as claimed with the exception of having an optical fiber, lenseless optical path from the optical fiber and the laser

source. It is also within the purview of one skilled in the art to recognize the functional equivalence of an optical fiber and an optical (quartz) rod, as decided in Manville Sales Corporation vs. Paramount Systems, Inc. 14 USPQ 2d 1291, 1291. Hasson provides a laser structure having a handpiece 20 with an optical fiber contained in the handpiece 16 and a laser
5 connector 44 being connected directly to a laser source 46.

It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to provide the laser delivery system of Taboada et al with a lenseless optical path, as disclosed by Hasson, for efficiency in beam transmission.

As to claim 14, to fixedly secure the optical fiber to the handpiece body (see Fig. 18 of
10 Taboada et al) with the exception of having it "otherwise loosely disposed in the handpiece tip" (see Fig. 17 of Taboada et al) would have been obvious to one having ordinary skill in the art at the time of applicant's invention to allow for the passage of fluids along either side as disclosed in Taboada et al (note col.10 lines 13-26).

Claims 2, 13, 15, and 34-36 are objected to as being dependent upon a rejected
15 base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 31- 33 are rejected under 35 U.S.C. § 103 as being unpatentable over applicants' disclosure in view of Taboada et al. Taboada et al disclose all aspects of the method claims, as applied above in the rejection of claim 30, except it fails to disclose the particular
20 materials, of subretinal fluid, being aspirated in conjunction with repetition of the application of the laser energy without replacing the probe. Applicants' specification (note page 12)

discloses that it is old to re-apply a suction probe as necessary to collect re-accumulated subretinal fluid between application of the laser probe.

To provide Taboada et al with additional steps of repetitious aspiration of particular ophthalmic materials between laser energy applications without probe replacement, as taught by
5 applicants' prior art disclosure, would have been obvious to one of ordinary skill in the art to reduce instrument placement into the eye during surgery, hence reducing delay time and thereby simplifying the procedure.

Claims 3-12 and 16-29 are allowable over the prior art of record.

Applicant's arguments filed in paper no. 4 dated 1-21-93 have been fully considered but
10 they are not deemed to be persuasive.

As to the assertion that Taboada et al lack particular elements, claimed in claim 1, such as the structure of the handpiece is incorrect. Note that in Figures 14-18, the handpiece is constructed of elements 20 and 80 in which the handpiece body is element 20 and the tip portion is illustrated in Fig. 14 (see col. 9 lines 39-44) as the region extending distally from the axis 16-
15 16. The tip does provide a fluid path from its distal end to the interior of the handpiece body.

As to the use of a quartz rod in lieu of an optical fiber, as cited above, the functional equivalence of an optical fiber and an optical (quartz) rod, as decided in Manville Sales Corporation vs. Paramount Systems, Inc. 14 USPQ 2d 1291, 1291. Also, note that the quartz rod 82 of Taboada et al is disposed in the handpiece body as well (beyond proximal end of 80)
20 as illustrated in Fig. 14. Taboada et al also shows the claimed fluid path 'running the length of the handpiece tip' as well as entering the interior of the handpiece body (note element 89 of

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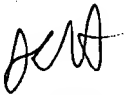
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Fig. 14). As to applicants' argument of the optical fiber being 'fixedly secured' to the handpiece body and is "otherwise loosely disposed in the handpiece tip", Taboada et al shows such structure as pointed out in the above rejection to claim 14. The structural elements provided by Taboada et al, in conjunction with those of Hasson, indeed read over the claimed subject matter.

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Any inquiry concerning this communication should be directed to Sonya C. Harris at telephone number (703) 308-0858.

S.C.H. 
March 15, 1993

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Group 330